REMARKS

Rejection of claims 61 to 63 and 68 to 72 under 35 U.S.C. § 102(e) as being anticipated by Ebner, *et al.*, U.S. 2003/0092133

Pursuant to the Applicant's response filed April 29, 2004 the final rejection under § 102(e) of claims 61 to 63 and 68 to 72 over US 2003/0003545 ("the '545 publication") was withdrawn. However, in the June 21, 2004 Office Action, claims 61 to 63 and 68 to 72 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. 2003/0092133 ("the '133 publication"), a divisional of the '545 publication. The Examiner states that the instant rejection is made for the same reasons set forth in the previous Office Action, Paper No. 13, mailed on February 25 because the '133 publication has the same disclosure as that of '545 publication. Applicants observe that the '133 and '545 publications claim priority, under § 119(e), to the same three provisional applications--No. 60/087,340, filed May 29, 1998; No. 60/099,805, filed Sept. 10, 1998; and No. 60/131,965, filed April 30, 1999.

In particular, the Examiner maintains that the '133 publication, "discloses a polynucleotide sequence, SEQ ID NO:28 which is 99.8% identical to the nucleotide 50-640 of SEQ ID NO:4 of the present invention, and encodes a polypeptide of IL-21 (SEQ ID NO:29) having 100% sequence identity to the amino acid sequence of SEQ ID NO:3 of the present invention...." The reference sequence, therefore, anticipates claims 61-63 and 72 as being a nucleic acid comprising DNA at least 95% to the sequence from position 50-640 of SEQ ID NO:4 (claim 61, part (c), for example), or to a nucleic acid encoding amino acid residues 1-197 or 19-197 of SEQ ID NO:3 (claim 72). Further, as the '133 publication teaches a vector comprising said nucleic acid, a host cell thereof, wherein the host cell is a CHO cell, an E.coli, a yeast or a Sf9 cell, and a process for producing the polypeptide encoded by the polynucleotide, it also anticipates claims 68-71.

Applicant respectfully traverses this rejection.

As an initial point, Applicant notes that the first of the three provisional applications to which the '133 publication claims priority under 35 U.S.C. § 119(e) does not, in fact, disclose the nucleic acid or polypeptide sequences cited by the Examiner (i.e., SEQ. ID NOS. 28 and 29). The sequences labeled as SEQ ID NOS: 28 and 29 in the publication first appeared in the provisional application filed on September 10, 1998; namely, provisional application No.

60/099,805 (the '805 application). As such, the '133 publication's disclosure cannot be given a prior art effective date under § 102(e) for the recited sequences (SEQ ID NOS: 28 and 29) as of the first-claimed filing date of the '340 application (i.e., May 29, 1998). The Examiner acknowledged this point regarding SEQ ID NO:29 in the Office Action dated February 10, 2004 in Applicants co-pending application, U.S.S.N. 09/854,208.

Applicant notes that it is well-settled law that a patent (and, by implication, a patent application published pursuant to 35 U.S.C. 122(b)) shall have effect under 35 U.S.C. § 102(e) as of a particular date only to the extent that there is a sufficient disclosure under 35 U.S.C. § 112, first paragraph, for the subject matter in question. If the patent or published application claims the benefit under 35 U.S.C. § 120 (and by implication under 35 U.S.C. § 119(e)) to an earlier filed application, that patent or published application shall not be entitled to prior art effect under § 102(e) if the earlier filed application does not provide a sufficient disclosure under 35 U.S.C. § 112, first paragraph for the subject matter in question. To be given effect under § 102(e), the claims of the reference patent must be supported in the manner required by 35 U.S.C. § 112 in the priority application whose date is relied on to establish the prior art status of the patent. *See In re Wertheim*, 646 F2d 527, 209 USPQ 554 (CCPA 1981); and MPEP 2136.03, sub-heading IV.

Applicant directs the Examiner's attention to the previously-presented declaration submitted pursuant to 37 CFR § 1.131, executed by the inventors of the present application, a copy of which is provided herewith. As noted above, the '133 publication claims priority to the same provisional applications and has the same disclosure as the '545 publication referred to in the declaration. Accordingly, Applicant submits that the declaration effectively antedates the '133 publication for the same reasons as the '545 publication, particularly in view of the observations provided above which establish that the '133 publication is not entitled to a prior art date pursuant to 35 U.S.C. § 102(e) of May 29, 1998 (i.e., the filing date of the '340 application).

Accordingly, Applicants submit that the '133 publication is not prior art to the present claims under § 102(e) and as such, cannot be relied upon to support a § 102(e) rejection of said claims. *See* MPEP § 2136.05. Applicant respectfully request the Examiner to withdraw the rejection of claims 61-63 and 68-72 under § 102(e) rejection based on the '133 publication.

Rejection of claims 64 to 67 under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under § 103(a) as obvious over US 2003/0092133.

For the reasons presented above in relation to the rejection of claims 61 to 63 and 68 to 72, Applicants maintain that the '133 publication is not prior art under 35 U.S.C. § 102(e) to the present application. As such, Applicants respectfully request the Examiner to withdraw the rejection of claims 64 to 67 under §102(e) and/or §103 based on the '133 publication.

Additional Comments

Applicants have not enclosed copies of the applications referred to in the declaration submitted pursuant to 37 CFR 1.131 but will do so upon request. Applicant notes that the applications were provided with the § 131 declaration as submitted in Applicant's response dated October 31, 2003.

In view of this response, Applicants submit that the present application is in condition for allowance and should be passed to issue. If, however, the Examiner believes that the rejection cannot be removed in light of the § 131 declaration evidence, Applicants requests that the Examiner declare an interference between the instant application and the '133 publication (U.S.S.N. 10/153,770). See MPEP § 2303. Applicants note that unless the current rejection is removed or an interference is declared between the two applications, Applicants have no process by which to continue the prosecution of the current invention and will be improperly precluded from demonstrating their entitlement thereto.

Respectfully submitted,
for GENENTECH, INC.

David A. Steffes
Registration No. 46,042

Date: December 21, 2004